Supreme Court, U.S.
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No. 00-1946

IN THE

Supreme Court of the United States

INSITUFORM TECHNOLOGIES, INC., INSITUFORM (NETHERLANDS) B.V., and INSITUFORM GULF SOUTH, INC.,

Petitioners,

v.

CAT CONTRACTING, INC., *et al.*,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION FOR RESPONDENTS CAT CONTRACTING, INC., FIRSTLINER U.S.A., GIULIO CATALLO, AND MICHIGAN SEWER CONSTRUCTION COMPANY

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STATEMENT PURSUANT TO RULE 29.6

Respondents, CAT Contracting, Inc., and FirstLiner U.S.A., are wholly owned subsidiaries of FirstLiner America. Respondent, Michigan Sewer Construction Company, has no parent company and no publicly held company owns 10% or more of its stock.

REPLY OF RESPONDENTS, CAT CONTRACTING, INC., FIRSTLINER U.S.A., GIULIO CATALLO, AND MICHIGAN SEWER CONTRUCTION COMPANY TO PETITION FOR WRIT OF CERTIORIARI

At the direction of the Court, the Respondents, CAT Contracting, Inc., FirstLiner U.S.A., Giulio Catallo, and Michigan Sewer Construction Company reply to the Petition for Writ of Certioriari of Petitioners Insituform Technologies, Inc. (also known as Insituform of North America), Insituform (Netherlands), B.V. (also known as Insituform Licensees BV), and Insituform Gulf South, Inc., collectively called "Insituform"as follows.

The Federal Circuit reversed and rendered the judgment against these defendants based on its application of *Festo Corp. v. Shoketsukinzoku Kogyo Kabushiki Co., Ltd.*, __ F.3d __, 56 USPQ 2nd 1865 (Fed. Cir. 2000) (en banc). For the reasons expressed in the parties briefing before the Federal Circuit and in the Federal Circuit's opinion, the retrospective application of *Festo* to cases still in the judicial process was entirely proper.

The question then becomes whether the grant of certiorari by this Court in the *Festo* case necessitates further review, either by this Court or by the Federal Circuit, of this case. There is considerable logical and legal merit in the proposition that, if a party narrows it's patent claims to obtain patent protection then it should not thereafter be permitted to expand the scope of patent protection via the doctrine of equivalents to include the very matters which it discarded during the patent application process.

This is precisely what Insituform did. The Co-Respondent's, Kanal Sanierung Hans Mueller GmbHJ & Co. KG, brief in this Court will chronicle the pertinent prosecution history in this regard. To avoid repetition, these Respondents hereby incorporate those portions of that brief by reference.

As long as this Court's decision in *Festo* generally adheres to the proposition that a patent holder may not deliberately narrow the scope of his intended patent protection in the application process and then expand it via infringement claims under the doctrine of equivalents, no further review of the Insituform case is warranted by this Court or the court below. On the other hand, counsel must in all candor admit that if this Court reverses *Festo* in a manner which modifies this basic tenet of its holding, then further review of the Insituform case would be warranted either by this Court or the Federal Circuit on remand.

Respectfully submitted,

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